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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,239	05/07/2004	Timothy L. Robinson	129510.11801	7593
21269 7590 08/20/2007 PEPPER HAMILTON LLP ONE MELLON CENTER, 50TH FLOOR 500 GRANT STREET PITTSBURGH, PA 15219			EXAMINER ROSARIO, DENNIS	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/840,239	Applicant(s) ROBINSON ET AL.	
	Examiner Dennis Rosario	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 36-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/10/05 1/13/05
6/30/05 7/12/06 11/27/06 4/11/07.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species I in the reply filed on 7/13/07 is acknowledged. The traversal is on the ground(s) that the examiner does not provide an explanation that the three species cannot be commonly searched. This is not found persuasive because via MPEP 821.01 wherein the examiner has reconsidered the election of species requirement and has come to the conclusion that the election is proper for the following reasons via MPEP 806.04(b):

"Where species under a claimed genus are not connected in any of design, operation, or effect under the disclosure, the species are independent inventions."

Thus, figures 2-4 are connected in design since the figures perform upgrading. Since both figures are connected in design, they are not independent; therefore,

"Thus, these species [figures 2-4] are not independent and in order to sustain a restriction requirement, distinctness must be shown." Via MPEP 806.05(j):

"...the inventions are distinct if

(A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive [claim 1 corresponding to species I includes upgrading data which is exclusive to:

- a) substituting data of claim 36 or species II and
- b) combining data of claim 52 or species III];

(B) the inventions *as claimed* are not obvious variants [the claimed upgrading data would not be obvious to one of ordinary skill in the art of upgrading data if one of ordinary skill in the art of upgrading data where using the claimed substituting data or combining data. The examiner does not see how the use of upgrading data would lead one of ordinary skill in the art of upgrading data to use combining data or substituting data with upgrading data.]; and

(C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function [since upgrading data, substituting data and combining data are different functions] , or effect. See MPEP 802.01.”; and MPEP 808.02:

“Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP 806.05(c)-806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

- (A) Separate classification thereof [
 - a1) species I that upgrades data classified in class 717/168;
 - a2) species II that substitutes in class 714/35 data and
 - a3) species III that combines data in class 382/116];...
- (B) A separate status in the art when they are classifiable together...
- (C) A different field of search...”

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 36-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species II and III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/13/07.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,3-5,7-18,28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Hillhouse et al. (US Patent 7,103,200 B2).

Regarding claim 1, Hillhouse discloses a method in a biometric authorization system, the method comprising:

- a) receiving biometric data (fig. 2: "Provide biometric input...") that is based on biometric information that is taken from a user;
- b) locating a user record (fig. 2: "Compare features to known templates...") associated with said user;
- c) upgrading biometric data (fig. 2: "...store...under same user profile" or storing new biometric data in a user profile is upgrading biometric data) associated with said user record using said received biometric data; and
- d) storing the upgraded biometric data (addressed in paragraph c), above) in said user record.

Regarding claim 3, Hillhouse discloses the method of claim 1, wherein said upgrading comprises:

- a) generating a new biometric sample (corresponding to fig. 2: "Process new biometric...") based on a combination of a previously registered biometric sample (corresponding to fig. 2: "...user profile") and a received biometric sample (corresponding to fig. 2: "Provide biometric input...").

Claim 4,5 and 7 are rejected the same as claim 3. Thus, argument similar to that presented above for claim 3 is equally applicable to claims 4,5 and 7

Regarding claim 8, Hillhouse discloses the method of claim 7, wherein said received biometric samples comprise:

- a) a plurality of biometric sample types (corresponding to fig. 2: "Form digital image...process for features" where features correspond to the claimed types).

Regarding claim 9, Hillhouse discloses the method of claim 1, further comprising:

- a) receiving a user identification code ("code" in col. 1, line 27).

Regarding claim 10, Hillhouse discloses the method of claim 1, wherein said upgrading is initiated by a third party system (or "security personnel" in col. 5, line 26).

Regarding claim 11, Hillhouse discloses the method of claim 1, wherein said upgrading occurs at scheduled time periods (or "periodically" in col. 5, line 26).

Regarding claim 12, Hillhouse discloses the method of claim 1, wherein said storing is determined (via fig. 2: "Distance...limits?") by the system (all of fig. 2).

Regarding claim 13, Hillhouse discloses the method of claim 1, wherein said storing comprises:

- a) storing (via fig. 4: "Cue...for storage...") a plurality of biometric data upgrade transactions (fig. 4: Class 1 to Class 3).

Regarding claim 14, Hillhouse discloses the method of claim 1, further comprising:

- a) comparing (fig 2: "Compare..."), at a local biometric device, said received biometric data or a biometric template based on said received biometric data with said biometric data associated with said user record.

Claim 15 is rejected the same as claim 14. Thus, argument similar to that presented above for claim 14 is equally applicable to claim 15.

Regarding claim 16, Hillhouse discloses a method for upgrading biometric data, the method comprising:

- a) authorizing a user (fig. 4: "Authenticate") at a local biometric device,
 - a1) said authorization being based on:
 - a11) a comparison (fig. 4: "Compare...") of first biometric data with second biometric data,
 - a111) wherein said first biometric data is based on:
 - a1111) a biometric sample provided (via fig. 4: "Provide biometric input...") by a user to said local biometric device and
 - a11112) said second biometric data is previously registered biometric data that is received by said local biometric device from a database (via fig. : "Authentication Server"); and
 - b) sending one of said first biometric data or said biometric sample to said database,
 - b1) one of said first biometric data or said biometric sample being used to upgrade said second biometric data (corresponding to "master enrollments are updated" in col. 6, lines 54,55) that is stored at said database.

Claims 17 and 18 are rejected the same as claims 9 and 12. Thus, argument similar to that presented above for claims 9 and 12 is equally applicable to claims 17 and 18, respectively.

Regarding claim 29, Hillhouse discloses the method of claim 16, further comprising:

a) receiving a request (corresponding to fig. 1: "Execute custom enrollment dialog") at said local biometric device that new biometric data should be forwarded to said database (fig. 1: "...database") to upgrade previously registered biometric data.

5. Claims 1,2,6,16,19-24,27 and 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Sukegawa (US Patent Application Publication No.: US 2004/0086157 A1).

Regarding claim 1, Sukegawa discloses a method in a biometric authorization system, the method comprising:

- a) receiving biometric data (fig. 10: "Input Image") that is based on biometric information that is taken from a user;
- b) locating a user record associated with said user (encompassing fig. 10: "Simi-larity of tentative...information...[between]...history information");
- c) upgrading biometric data (fig. 10: "Replace...information") associated with said user record using said received biometric data; and
- d) storing the upgraded biometric data (corresponding to fig. 10: "Replace...information") in said user record.

Regarding claim 2, Sukegawa discloses the method of claim 1, wherein said upgrading comprises:

- a) substituting a previously registered biometric sample with a received biometric sample (corresponding to fig. 10: "Replace...information") if said received biometric sample is of a higher quality (or "similarity...becomes higher" in [0121], lines 13-15).

Claim 6 is rejected the same as claim 2. Thus, argument similar to that presented above for claim 2 is equally applicable to claim 6.

Claim 16 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 16.

Claims 19 and 20 are rejected the same as claim 2. Thus, argument similar to that presented above for claim 2 is equally applicable to claims 19 and 20.

Regarding claim 21, Sukegawa discloses the method of claim 20, wherein the characteristics are minutia points (or "fingerprint image" in [0033]) of the first biometric data and the second biometric data.

Regarding claim 22, Sukegawa discloses the method of claim 20, wherein the characteristics are aspects of clarity (or visual similarities) of the first biometric data and the second biometric data.

Regarding claim 23, Sukegawa discloses the method of claim 20, wherein the characteristic is size (as indicated in fig. 2: "...Length...")of the first biometric data and the second biometric data.

Regarding claim 24, Sukegawa discloses the method of claim 20, wherein the characteristic is liveness (such as a persons face in fig. 2) of the first biometric data and the second biometric data.

Regarding claim 27, Sukegawa discloses the method of claim 20, wherein the characteristic is biometric device data (or data from a database in fig. 1,num.110).

Regarding claim 31, Sukegawa discloses a method in a biometric authorization system, the method comprising:

- a) receiving, at a database (fig. 1,num. 108), biometric data (from fig. 1,num. 107) that is based on biometric information taken from a user (fig. 1,num. 100) at a local biometric device (fig. 1,num. 102);
- b) locating (via fig. 1,num. 109), at said database, a user record associated with said user;
- c) authorizing (via fig. 10: "Larger...authenticated") said user at said database, said authorization being based on a comparison using said received biometric data and second biometric data that is associated with said located user record;
- d) determining (via a decision diamond of fig. 10: "Simi-larity...information") whether said received biometric data is useful (via the YES branch of similarity information) to upgrade (fig. 10: "Replace...information") said second biometric data;
- e) upgrading (fig. 10: "Replace...information") said second biometric data associated with said user record using said received biometric data, if it is determined that said received biometric data is useful (via said YES branch) to upgrade said second biometric data; and
- f) storing (corresponding to fig. 10: "Replace...information") the upgraded biometric data in association with said user record.

Regarding claim 32, Sukegawa discloses the method of claim 31, wherein said locating is based on a receipt of a user identification code ("ID code" in paragraph [0041]).

Claim 33 is rejected the same as claim 2. Thus, argument similar to that presented above for claim 2 is equally applicable to claim 33.

Claim 34 is rejected the same as claim 31, paragraph e). Thus, argument similar to that presented above for claim 31,e) is equally applicable to claim 34.

Regarding claim 35, Sukegawa discloses the method of claim 31, wherein said determination is based on an age of previously registered biometric data (as indicated in fig. 3: "Flow of time base").

6. Claims 16,29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (US Patent 6,928,547 B2).

Regarding claim 16, Brown discloses a method for upgrading biometric data, the method comprising:

- a) authorizing (fig. 3,num. 317) a user at a local biometric device,
 - a1) said authorization being based on:
 - a11) a comparison (fig. 3,num. 317) of first biometric data with second biometric data,
 - a111) wherein said first biometric data (fig. 3,num. 313) is based on:
 - a1111) a biometric sample provided by a user to said local biometric device and
 - a11112) said second biometric data is previously registered biometric data (corresponding to fig. 3,num. 317) that is received by said local biometric device from a database (fig. 2,num. 220 or "Authentication database" in col. 9, line 54); and
- b) sending (via an unlabeled bus in fig. 2) one of said first biometric data or said biometric sample to said database,

c) one of said first biometric data or said biometric sample being used to upgrade (or "update" in col. 9, line 53) said second biometric data (or "key" in col. 9, line 55) that is stored at said database.

Regarding claim 29, Brown discloses the method of claim 16, further comprising:

a) receiving a request (or "database request" in col. 9, line 29) at said local biometric device that new biometric data should be forwarded to said database to upgrade (or "update" in col. 9, line 29) previously registered biometric data (or "key" in col. 9, line 55).

Claim 30 is rejected the same as claim 29. Thus, argument similar to that presented above for claim 29 is equally applicable to claim 30.

7. Claims 16,18-20,25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kyle (US Patent 6,853,739 B2).

Regarding claim 16, Kyle discloses a method for upgrading biometric data, the method comprising:

- a) authorizing a user (fig. 10: "Verify...Passport") at a local biometric device,
 - a1) said authorization being based on:
 - a11) a comparison (fig. 10: "Does Face match...") of first biometric data with second biometric data,
 - a111) wherein said first biometric data is based on:
 - a1111) a biometric sample (or passport) provided by a user to said local biometric device and
 - a11112) said second biometric data is previously registered biometric data (corresponding to (fig. 10: "Search...Database") that is received by said local biometric device from a database; and
 - b) sending (via fig. 10: "Enroll Face...") one of said first biometric data or said biometric sample to said database,
 - c) one of said first biometric data or said biometric sample being used to upgrade (or "update" in col. 13, line 51) said second biometric data that is stored at said database.

Regarding claim 18, Kyle discloses the method of claim 16, further comprising:

a) determining (via an "administrator" in col. 13, line 51) whether said second biometric data should be upgraded (or "update" in col. 13, line 51).

Regarding claim 19, Kyle discloses the method of claim 18, wherein said determining comprises:

a) determining whether said second biometric data is of higher quality than said second biometric data (since the second data is of "poor quality" in col. 13, line 33).

Claim 20 is rejected the same as claim 19. Thus, argument similar to that presented above for claim 19 is equally applicable to claim 20.

Regarding claim 25, Kyle discloses the method of claim 20, wherein the characteristic is system attendant biometric sample certification (or "training" in col. 10, line 18) of the first biometric data and the second biometric data.

Regarding claim 26, Kyle discloses the method of claim 25, wherein said system attendant biometric sample certification comprises:

a) a system attendant ranking (or "does not require extensive training" in col. 10, line 18 as opposed to an operator that has no training).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sukegawa (US Patent Application Publication No.: US 2004/0086157 A1) in view of Hoffman et al. (US Patent 6,397,198 B1).

Regarding claim 28, Sukegawa teaches that biometric data can be transferred to "another terminal" in paragraph [0130], line 8.

Hoffman teaches a network as shown in fig. 1 that includes transmission of data and terminals as known to one of ordinary skill in networks and claim 28 of:

Regarding claim 28, Sukegawa discloses the method of claim 27 of:

- a) a terminal identification code (or "hardware identification code" in col. 5, lines 23,24),
- b) a system attendant code,
- c) a system operator identification code, and
- d) transmission capabilities information.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to use Hoffmans's code to identify a specific terminal with Sukegawa's teaching of transferring to another terminal so that the desired terminal from a group of

terminals can be quickly identified from the group of terminals so as to obtain the transferred data.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Rosario whose telephone number is (571) 272-7397. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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